



03 SEP 2003

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In re Application of :
LOOSMORE, Sheena M. *et al* :
U.S. Application No.: 10/031,165 :
PCT No.: PCT/CA00/00870 :
Int. Filing Date: 26 July 2000 :
Priority Date: 27 July 1999 :
Attorney Docket No.: 1038-1217 MIS :
For: RECOMBINANT HIGH MOLECULAR :
WEIGHT MAJOR OUTER MEMBRANE :
PROTEIN OF MORAXELLA :

**DECISION ON
RENEWED PETITION
UNDER 37 CFR 1.47(a)**

This is a decision on applicants' "Renewed Petition under 37 C.F.R. 1.47(a)" filed on 24 July 2003.

BACKGROUND

On 18 March 2003, a decision dismissing applicants' petition under 37 CFR 1.47(a) was mailed. Applicants failed to satisfy items (2) and (3) of 37 CFR 1.47(a). Applicants were given two months to respond with extensions of time available.

On 24 July 2003, applicants filed the instant petition which was accompanied by, *inter alia*, another "Declaration Under 37 CFR 1.47(a)" ("2d.Decl.") by Reza Yacoob; a copy of a letter to the nonsigning co-inventor dated 30 May 2003; a copy of a FedEx tracking letter; and a three-month extension request and \$930.00 extension fee.

DISCUSSION

The 37 CFR 1.47(a) applicant failed to satisfy items (2) and (3) of 37 CFR 1.47(a) with the papers filed 04 October 2002. Items (1) and (4) were completed.

Concerning item (2), the prior decision noted that it was not clear whether Mr. Sasaki could not be reached or is refusing to join in the application.

In the renewed petition, the 37 CFR 1.47(a) applicant submitted another declaration by Reza Yacoob who claims that she sent "a copy of the Declaration and Power of Attorney, with a request that it be signed and returned along with a copy of published PCT WO 01/07619 of which this is the U.S. National Phase filing" on 30 May 2003 to the last known address of Ken Sasaki. 2d.Decl. at ¶ 2.

Petitioner included a copy of the letter accompanying the documents with the renewed petition. In addition, a copy of the tracking documents for Federal Express verifying delivery to NPS Pharmaceuticals on 02 June 2003 was also provided.

Later, Ms. Yacoob attests that “[o]n June 10, 2003, I telephoned Ken Sasaki at NPS and left a voice-mail message . . . When I received no reply to this message, I telephone Ken Sasaki again on June 17, 2003 and again reached his voice mail.” Id. at ¶ 4. Ms. Yacoob proclaims that “[t]o date, I have received no return phone calls and neither has the signed Declaration and Power of Attorney been received.” Id. at ¶ 5.

This evidence is sufficient to show that the conduct of the nonsigning co-inventor constitutes a refusal and meets the requirements of section 409.03(d) of the MPEP. Thus, item (2) of 37 CFR 1.47(a) is now satisfied.

Concerning item (3), the 37 CFR 1.47(a) applicant was asked to explain why the above-captioned application was sent to the address of a company instead of Mr. Sasaki's residence which is listed on the Initial Information Data Sheet. Section 409.03(e) of the MPEP notes that the last known address should be the last known address at which the inventor customarily receives mail. This is ordinarily the last known residence of the nonsigning inventor.

In the renewed petition, Ms. Yacoob contends that the “prior correspondence referred to in my Declaration of August 13, 2002 and referred to in this Declaration were directed to Ken Sasaki at his place of business, namely NPS Pharmaceuticals, since this is the forwarding address that Ken Sasaki gave the Human Resources Department of Aventis Pasteur Limited upon termination of his employment on November 19, 2001. Id. at ¶ 6. This explanation is sufficient to meet the requirement of the MPEP and item (3) of 37 CFR 1.47(a). It is also noted that petitioner states that the correct name of the corporate entity is NPS Pharmaceuticals, not MDS Pharmaceuticals as listed in the initial petition. This was as a result of a clerical error.

Hence, the last known address of Ken Sasaki is:

NPS Pharmaceuticals
6850 Goreway Drive
Mississauga, Ontario
Canada, L4V 1V7

Therefore, all the requirements of 37 CFR 1.47(a) are now complete.

CONCLUSION

Applicants' renewed petition under 37 CFR 1.47(a) is **GRANTED**.

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 26 July 2000 under 35 U.S.C.

363, and a 35 U.S.C. 371 date of 04 October 2002.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record and will be published in the Official Gazette.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.

A handwritten signature in black ink that reads "James Thomson". The signature is written in a cursive style with a large, stylized "J" and "T".

James Thomson
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PROTEIN OF MORAXELLA

Dear Mr. Sasaki:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. § 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.


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